



UNITED STATES DEPARTMENT OF COMMERCE
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EXAMINER	
HINDENBURG, M	
ART UNIT	PAPER NUMBER
335	5

DATE MAILED: 05/08/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

<input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	<input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.
<input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449	<input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152
<input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474	<input type="checkbox"/> _____

Part II SUMMARY OF ACTION

1. Claims 1-24 are pending in the application.

Of the above, claims 21-24 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-20 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. These drawings are acceptable; not acceptable (see explanation).

10. The proposed drawing correction and/or the proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved. disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20, drawn to a heating apparatus, classified in Class 128, subclass 303.1.

II. Claims 21-^4, drawn to a method for effecting cauterization, classified in Class 128, subclass 303.1.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP 806.05(e).

In this case, the apparatus as claimed can be used to practice another and materially process such as the treatment of the rectal canal with mild heat.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II restriction for examination purposes as indicated is proper. For example, a search for Group I would include 251/298 which would not be required of Group II.

During a telephone conversation with Mr. Birde on April 13, 1989 a provisional election was made with traverse to prosecute the invention of the heating apparatus, claims 1-20. Affirmation of this election must be made by applicant in responding to this Office action. Claims 21-24 withdrawn from further consideration by the

examiner as being drawn to a nonelected invention. See 37 CFR 1.142(b).

Claims 2-7, 11, 12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is indefinite in that an "external" tubing and "internal" tubing lacks antecedent basis in the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Claims 1, 8, and 18 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ginsburg et al. Ginsburg et al. disclose an apparatus as claimed by applicant.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f)

and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 2-5, 9-12 and 20 are rejected under 35 U.S.C. 103 as being unpatentable over Ginsburg et al. in view of Kozinski. Kozinski teaches a catheter with an external and internal tubing. It would have been obvious to one of ordinary skill in the art, in view of Kozinski, to use an external tubing with the catheter of Ginsburg et al. to protect the tubing with bladder from damage. In regard to claims 4 and 5, Ginsburg et al further state a wire can be used in place of the laser. In regard to claims 9-12, it would have been an obvious engineering design choice to use a bladder to withstand such a pressure and temperature to keep the patient sofe and to use latex rubber and Teflon with the ele-
ments of Ginsburg et al. since both are with known material with well known benefits.

Claims 6 and 7 are rejected under 35 U.S.C. 103 as being unpatentable over Ginsburg et al. in view of Kozinski as applied to claims 2-5, 9-12 and 20 above, and further in view of Landman et al. Landman et al. teach pumping means comprising a hypodermic barrel and a three-way valve to control fluid flow. It would have been obvious in view of Landman et al, to control the injection of fluid and to use a three-way valve with the tubing of Ginsburg et al. to control fluid flow therin.

Claims 13 and 15-17 are rejected under 35 U.S.C.

103 as being unpatentable over Ginsburg et al in view of Solar. Solar teaches a catheter with a bladder having time control means which could be electronic means. It would have been obvious in view of Solar, to use such a time control means with the other means of Ginsburg et al. to better control the bladder. Since Solar teaches electronic means can be used as the time control means, it is obvious such a means could include a programmable clock.

Claim 14 is rejected under 35 U.S.C. 103 as being unpatentable over Ginsburg et al. in view of Solar as applied to claims 13 and 15-17 above, and further in view of Wood. Wood teaches temperature control means comprising a thermocouple and temperature display. It would have been obvious, in view of Wood, to use a thermocouple and temperature display means with Ginsburg et al. to facilitate temperature control.

Claim 19 is rejected under 35 U.S.C. 103 as being unpatentable over Ginsburg et al. in view of Moore et al. Moore et al teach a catheter with scale graduations thereon. It would have been obvious in view of Moore et al., to use such a scale on the catheter of Ginsburg et al. to indicate the depth of insertion of the catheter into the body.

The remaining references are cited to show other heating devices. No PTO-1449 was with the submitted prior art.

Mr. Hindenburg:bhw
04/27/ 89
05/01/89

Max Hindenburg
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EXAMINER
ART UNIT 335